

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES PARKER
and JEFFREY ST. THOMAS

Appeal No. 99-1173
Application 08/718,122¹

ON BRIEF

Before CALVERT, CRAWFORD and BAHR, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 4, 6 to 13 and 15 to 21, all the claims remaining in the application.

¹ Application for patent filed September 18, 1996.

Appeal No. 99-1173
Application 08/718,122

The appealed claims are drawn to a wrench for threading and unthreading soft golf spikes, and are reproduced in Appendix A of appellants' brief.

The references applied in the final rejection are:

Lederer	3,043,171	Jul. 10, 1962
Hall et al. (Hall)	4,584,914	Apr. 29, 1986
Schley	5,003,681	Apr. 2, 1991

The claims on appeal stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over the following combinations of references²:

- (1) Claims 1, 3, 4, 6 to 10, 12, 13, 15 to 18, 20 and 21, Schley in view of Lederer;
- (2) Claims 2, 11 and 19, Schley in view of Lederer and Hall.

Rejection (1)

The basis of this rejection, as set forth on page 2 of the final rejection, is:

Schley discloses all of the claimed subject matter except for having sharp tips on plural pins. Schley discloses that more than one pin may be used. Lederer discloses sharp tips on four pins aligned in a square. It would have been obvious to one having ordinary skill in the art to form the pins of Schley

² An additional rejection of claims 5 and 14 under 35 U.S.C. § 112, second paragraph, was overcome by the amendment filed on April 20, 1998.

Appeal No. 99-1173
Application 08/718,122

as four aligned pins with sharp tips to grip the
workpiece as taught by Lederer.

We will not sustain this rejection.

It is fundamental that, "[u]nder Section 103, teachings
of references can be combined only if there is some suggestion
or incentive to do so." ACS Hospital Systems, Inc. v.
Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933
(Fed. Cir. 1984). In the present case, even assuming that
Schley and Lederer are analogous art, we find no suggestion or
incentive to combine them in the manner proposed by the
examiner. The purpose of the Schley apparatus is to turn a
brake piston 20 when installing brake pads in an automobile,
while the purpose of the Lederer apparatus is to remove a
disposable oil filter or other device having a "puncturable
housing" (col. 3, lines 6 to 10). Lederer provides prongs 2
with points 3 so that the prongs can puncture the filter
housing 4, whereupon it can be unscrewed. The fact that this
renders the filter unusable is of no consequence to Lederer,
since it is disposable and not intended for reuse (col. 2,
lines 48 to 51). On the other hand, in using the tool of
Schley to rotate a brake piston, the piston is not intended to

Appeal No. 99-1173
Application 08/718,122

be removed³, and certainly Schley does not teach, nor would one of ordinary skill desire, that the piston be punctured or otherwise rendered incapable of any further use. Lederer would, therefore, furnish no motive or suggestion for one of ordinary skill to provide sharp points on the pin or pins 30 of Schley, since the purpose taught by Lederer for such pointed pins, i.e., to puncture the item being rotated, would be inimical to the manner in which the Schley tool is intended to be used.

Rejection (2)

This rejection will not be sustained since the additional reference, Hall, does not overcome the deficiency noted in the combination of Schley and Lederer.

Conclusion

The examiner's decision to reject claims 1 to 4, 6 to 13 and 15 to 21 is reversed.

REVERSED

³ As Schley states at col. 1, lines 18 to 22, the piston is rotatably mounted to provide sufficient clearance for the installation of brake pads.

Appeal No. 99-1173
Application 08/718,122

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Administrative Patent Judge)	
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Administrative Patent Judge)	APPEALS AND
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